

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

JUL 18 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES EDWARD JOHNSON

Application No. 10/689,289

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on July 12, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing is identified below:

A review of the file indicates that on April 7, 2006, appellants filed an Appeal Brief under the rules set forth in 37 CFR § 1.192(c). However, 37 CFR § 1.192 was abolished on September 13, 2004, and replaced by 37 CFR § 41.37(c). Accordingly, the Appeal Brief filed on April 7, 2006 does not comply with 37 CFR § 41.37(c).

A review of the application indicates that the following sections are missing from the Appeal Brief of April 7, 2006:

1) "Summary of claimed subject matter" as set forth in 37 CFR § 41.37(c)(1)(v);

A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

2) "Grounds of rejection to be reviewed on appeal", as set forth in 37 CFR § 41.37(c)(1)(vi);

A concise statement of each ground of rejection presented for review.

3) "Evidence appendix", as set forth in 37 CFR § 41.37(c)(1)(ix);

An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

4) "Related proceedings appendix", as set forth in 37 CFR § 41.37(c)(1)(x).

An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

A substitute brief that is in compliance with 37 CFR § 41.37(c) is required. For more information on the Board's new rules see the web page entitled More Information on the Rules of Practice Before the BPAI, Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/index.html>.

Accordingly it is

ORDERED that the application is returned to the Examiner to:

1) hold the Appeal Brief of April 7, 2006 defective;
2) for applicant to file a substitute Appeal Brief in compliance with 37 CFR § 41.37;

3) for the examiner to consider the substitute Appeal Brief, and if necessary, vacate the Examiner's Answer mailed June 1, 2006, and issue a revised Examiner's Answer in accordance with the new rules;

4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By:



DALE M. SHAW

Deputy Chief Appeal Administrator
(571) 272-9797

Steven J. Rosen
Patent Attorney
4729 Cornell Rd.
Cincinnati OH 45241

DMS/eld